

REMARKS

Reconsideration and allowance of the subject patent application are respectfully requested.

This amendment accompanies a Request for Continued Examination.

The Amendment submitted on October 26, 2001 is objected to as allegedly containing new matter. Specifically, the paragraph

For example, if the recipient registered a \$2000 computer system, a giver can come in and contribute \$100 toward its purchase. This is useful as it permits several of the recipient's friends to each pay for a part of an expensive gift without having to get together ahead of time to discuss how much each is paying. Each person can simply pay as much as they are comfortable with.

allegedly contains new matter. However, this paragraph is found on page 14 of the provisional application from which this application claims priority.¹ The contents of the provisional application are expressly incorporated by reference into this application. *See*, e.g., page 1, lines 5-7 of this application ("This application claims the benefit of U.S. Provisional Application No. 60/138,538, filed on June 10, 1999, for, UNIVERSAL GIFT REGISTRY METHOD AND SYSTEM, **the content of which is incorporated herein by reference.** (emphasis added)). Consequently, the amendment of the subject patent application to include the above paragraph cannot constitute the introduction of new matter. Accordingly, withdrawal of the new matter objection and entry of the amendment adding the above paragraph are respectfully requested.

¹ A copy of this provisional application was previously submitted for the Examiner's convenient reference.

Claims 195-211 were rejected under 35 U.S.C. Section 112, first paragraph, as allegedly containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Specifically, the office action alleges that the limitation "wherein the commitment of each giver that commits to make a monetary contribution is for any giver-desired portion of the uncommitted balance of the gift's purchase price" is not taught by the specification. Applicants respectfully traverse this rejection. The originally filed disclosure clearly provides examples of "amounts" which are expressed in monetary units. Indeed, "purchase amount" is described on page 12, lines 7-15 of the specification as "a financial value, such as a dollar amount, that is associated with a purchase request." Thus, while disclosure does not limit "amounts" to "dollar" amounts, there is clear and unambiguous disclosure evidencing the inventors' possession of the concept of a giver committing to make a monetary (*e.g.*, dollar) contribution value toward the uncommitted balance of the purchase price of a gift. For these reasons, Applicant respectfully requests that the rejection of claims 195-211 under 35 U.S.C. Section 112, first paragraph, be withdrawn.

Claims 195-211 were rejected under 35 U.S.C. Section 112, second paragraph, as allegedly being indefinite. The office action alleges that there is insufficient antecedent basis for the recitations of "the gift's purchase price" in the independent claims. The now-entered amendment of February 25, 2002 is believed to address this antecedent basis issue and withdrawal of the Section 112, second paragraph, rejection is respectfully requested.

Claims 199 and 200 are not rejected based on prior art. Because the Section 112 rejections of these claims are believed to be overcome as set forth above, these claims are now believed to be allowable.

Claims 195, 196, 198, 201, 204-208 and 210-214² were rejected under 35 U.S.C. Section 102(e)³ as allegedly being "clearly anticipated" by "UCOPIA: Ucopia Unveils New Wedding Registry Partners ..." (the "Ucopia document"). For a prior art reference to anticipate a claim, the reference must disclose each and every element of the claim with sufficient clarity to prove its existence in the prior art. See, *e.g.*, *Motorola, Inc. v. Interdigital Technology Corp.*, 43 USPQ2d 1481, 1490 (Fed. Cir. 1997). Even assuming (without admitting) that the Ucopia document is enabling for the system disclosed therein, the Ucopia document does not disclose each and every element of the claims rejected based thereon and therefore the Ucopia document cannot anticipate these claims.

Independent claim 195, 199, 200, 207, 208 and 209 are directed, among other things, to enabling a plurality of gift givers to each make a respective commitment for a monetary contribution of *any giver-desired amount* toward a gift for a gift recipient and to automatically generating a purchase request for the selected gift if the total of the commitments is equal to or greater than the gift's purchase price. The "partial purchase" feature is described, for example, on pages 24-26 of the subject application and permits a plurality of gift-givers to each make a contribution toward a gift. Significantly, in

² Claims 195-211 were pending in this application at the time of the office action. Accordingly, the inclusion of claims 212-214 in the statement of the rejection is incorrect.

³ Section 102(e) sets forth conditions under which certain patent applications constitute prior art. The Ucopia document is not a patent application and thus it may not be used in a Section 102(e) rejection. Should the Examiner continue to maintain that the Ucopia document anticipates any claimed subject matter, Applicant requests that the rejection be based on an appropriate paragraph(s) of Section 102.

accordance with the methods and systems set forth in these claims, each gift giver can make a commitment for *any giver-desired amount* toward a gift. See, e.g., claim 195, ll. 18-20 (“...wherein the commitment of each giver that commits to make a monetary contribution is for *any giver-desired portion of the uncommitted balance* of the gift's purchase price”).

The Ucopia system provides a “group purchase” feature in which

[c]ouples designate an item for group purchase on their registry form and specify the dollar amount of shares to be sold. Typically, a share is \$50. Individual guests can then purchase one or more shares. The gift remains on the couple's registry until it is fully purchased. If the full purchase price is not reached, the couple may either purchase the remaining shares or obtain a gift certificate to the retailer for the total amount of the shares already purchased. *Ucopia website, Frequently Asked Questions*

The Ucopia document does not disclose (or even suggest) a method or system in which each giver can commit to make a monetary contribution for any giver-desired portion of the uncommitted balance of the gift's purchase price. In the Ucopia system, the commitment of each giver that commits toward the purchase of a gift is constrained by the share price specified for that gift. Thus, a user may not contribute \$25 or \$75, for example, toward the purchase of a gift whose share price has been set to \$50. In complete contrast to the Ucopia system, the claimed method and system permit a gift giver to contribute as much or as little as he or she wants. This results in greater convenience for gift recipients, and maximizes the amount of gifts received. For example, a gift giver wishing to spend \$75 can spend exactly \$75.

For at least these reasons, the Ucopia document cannot possibly anticipate the subject matter of claims 195, 199, 200, 207, 208 and 209 or the claims dependent therefrom.

It is alleged on page 7 of the office action that "[s]ince the share price can be varied without limit it is anticipated that each giver can commit any giver-desired portion of the uncommitted balance..." There is no disclosure in the Ucopia document or the Ucopia website supporting this assertion. In the Ucopia system, the gift recipient sets the share price at the time the gift is registered and this share price imposes the constraints on the amount that a gift giver can contribute as discussed above. There is absolutely no disclosure of somehow varying the share price "without limit" so that each giver can commit any giver-desired portion of the uncommitted balance.

Page 3 of the office action asserts that "givers can contribute any amount (i.e. any number of share (sic) including a fraction of a share) towards the gift." This is incorrect. At the time a gift is purchased, the gift giver in the system described in the Ucopia document must give at least one share ("Individual guests can the purchase one or more shares"). There is no provision, disclosure or suggestion in the Ucopia system for giving less than one share or of "fractional" shares. For example, if the gift recipient has set the share price for a gift at \$50, the gift giver cannot contribute \$25 toward the purchase of that gift. There is also no provision, disclosure or suggestion in the Ucopia document for giving an amount that is between the cost of one and two shares. If the share price is \$50, it is not possible to contribute \$75. The end result is that in the first case, some givers may not be able to afford the share price and in the second case the gift giver contributes less than he or she might have.

In connection with claims 196 and 211, the office action further asserts that "since each share represents an underlying predetermined fixed monetary amount, the giver may specify any amount of money appropriate to monetary value of a gift by specifying

number of share that represent his/her desired contribution..." It is however not true that the Ucopia system permits a gift giver to specify any amount of money. For example, if the share price is \$50, it is not possible for the gift giver to contribute \$25, nor is it possible for the gift giver to contribute \$75. In addition, while a gift giver in the Ucopia system may specify one share, two shares, etc., there is no disclosure or suggestion of the gift giver *directly* specifying his/her commitment as an amount of money as claimed. For these additional and independent reasons, Applicant submits that the Ucopia document does not anticipate the subject matter of claims 196 and 211.

With respect to claims 204-206, Applicant traverses the assertion in the office action that the features such as a recipient-specified price and a recipient-specified vendor are "well-established business practices" that are "inherent" in the Ucopia document. Inherency may not be established by probabilities or possibilities. The mere fact that a certain thing *may* result from a given set of circumstances is *not sufficient* to establish inherency. See, *e.g.*, *Continental Can Co. v. Monsanto Co.*, 20 USPQ2d 1746, 1749 (Fed. Cir. 1991). There is no disclosure in the Ucopia document of the features of claims 204-206 and there is no evidence establishing that the Ucopia system must necessarily possess these features. For example, there is no disclosure of recipient-determined prices or vendors for gift ideas as specified in claims 205 and 206, respectively. The Examiner is respectfully requested to provide evidence such as a reference or affidavit to demonstrate the alleged inherency of the features of claims 205 and 206 should this rejection be maintained. In addition, while the Ucopia system provides that incomplete purchases can be given to the registrant in gift certificates, there is no disclosure of providing the commitments for monetary contributions to the gift recipient as cash if the

total of the commitments is less than the gift's purchase price as specified in claim 204. Unlike cash, gift certificates generally (1) can only be used in certain stores; (2) have expiration dates; and (3) are generally non-transferable. Moreover, gift certificates are backed only by the credit of each respective store.

Claims 197, 202 and 203 were rejected under 35 U.S.C. Section 103(a) as allegedly being "obvious" over the Ucopia document in view of the "weddingchannel.com" document. The weddingchannel.com document is applied as teaching a registry in which web pages are generated and supplied to gift givers. However, the weddingchannel.com document does not remedy the above-noted deficiencies of the Ucopia document in connection with claim 195 (from which claims 197, 202 and 203 depend). As such, even assuming for the sake of argument that the combination of these documents would have been proper and that the combination were made, the subject matter of claims 197, 202 and 203 would not result.

In addition, claim 202 calls for receiving commitments from the gift givers that include commitments which are contingent upon other gift givers making commitments such that the total of all commitments is equal to or greater than the price of the selected gift. This feature is not disclosed or even remotely contemplated in the Ucopia document or the weddingchannel.com document. The office action takes official notice that

...specifying substitute gift item (for example as an item of second choice) and providing cash in lieu of gift item if the gift item is unavailable or cannot be collectively purchased is old and well-known business practice.

However, the feature of a gift giver making a commitment contingent upon commitments of others as set forth in claim 202 is not a gift substitution feature. Applicants respectfully request that evidence such as a reference or affidavit be provided to support

the contentions in the office action with respect to claim 202 should this rejection be maintained.

With respect to claim 203, Applicant believes that the general business practice with respect to out-of-stock or otherwise unavailable gifts was to cancel the order and issue a refund to the gift giver. The result of this practice is that the gift giver must select and purchase another gift. As set forth in claim 203, the claimed method permits the gift recipient to specify a substitution option for the gift idea. Prior to the present invention, "gift substitution" typically occurred when a recipient decided after receiving a gift that he/she did not want the gift or had received a duplicate gift from a different source. To return the unwanted gift the gift recipient had to either return to the store or ship the gift back to the store, which is costly. The method of claim 203 allows the gift recipient to specify a substitution option for cash or for a different gift before a gift is shipped, or even before it is "given" by the gift giver and therefore avoid the cost of having to return to the store or to ship the gift back to the store. Applicant submits that this is not a well-known business practice. Applicants request that evidence such as a reference or affidavit be provided to support the contentions in the office action regarding the gift-substitution option of claim 203 should any rejection of this claim be maintained.

New claims 212-239 are added for the Examiner's consideration. The subject matter of these new claims is fully supported by the original disclosure and no new matter is added. New independent claims 212 and 228 each specifies, among other things, that the commitment of each giver for part of a total gift amount is directly specified by the gift giver as an amount of currency. The applied art does not teach or suggest this feature. Accordingly, these claims are believed to be allowable. The claims

that depend from claims 212 and 228 are believed to be allowable because of their dependency and because they contain additional features not taught or suggested by the applied art. New independent claims 220 and 234 each specifies, among other things, that each giver is able to commit for part of the total gift amount specified for a selected gift even if only the total gift amount for the selected gift is specified. The applied art does not teach or suggest this feature. In particular, the Ucopia document specifies that, among other things, a share price must be specified for a gift in order to implement the so-called "group purchase" feature. Accordingly, these claims are believed to be allowable. The claims that depend from claims 220 and 234 are believed to be allowable because of their dependency and because they contain additional features not taught or suggested by the applied art.

Applicant submits that the pending claims are in condition for allowance, and action to that end is earnestly solicited.

Respectfully submitted,

NIXON & VANDERHYE P.C.



Michael J. Shea
Registration No. 34,725

1100 North Glebe Road, 8th Floor
Arlington, Virginia 22201-4714
Telephone: (703) 816-4000
Facsimile: (703) 816-4100
MJS:dbp